

**REMARKS**

Claims 33, 35-37, 39-53 and 56 are pending in the application and are subject to rejection.

Initially, the Examiner is respectfully requested to acknowledge Applicants' claim to priority under 35 U.S.C. § 119, and to indicated that the certified copies of the priority documents have been received.

In addition, the Examiner is respectfully requested to indicate that the drawings filed on January 17, 2002 are acceptable.

**I. Specification**

At page 2 of the Office Action, the Examiner objects to the specification because in the first paragraph, the parent application should be referred to as a "371" not a "continuation" of the PCT application.

The first paragraph has been amended by changing "continuation" to --371-- and by updating the first paragraph to reflect that the parent application has issued as U.S. Patent 6,365,299.

In view of the above, withdrawal of the foregoing rejection is respectfully requested.

**II. Response to Rejection of claims 33, 35-37, 39-53 and 56 under 35 U.S.C. § 103(a)**

In paragraph 3 at pages 2-3 of the Office Action, claims 33, 35-37, 39-53 and 56 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kawakami et al. (U.S. Patent 5,824,434) in view of Idota et al. (U.S. Patent 5,618,640).

Applicants respectfully traverse the rejection and submit that one of ordinary skill in the art would not be motivated to combine Kawakami et al. and Idota et al.

The present invention relates to a nonaqueous secondary battery comprising a positive electrode containing a material capable of reversibly intercalating and deintercalating lithium, a negative electrode containing a composite oxide containing tin represented by formula (3):  $\text{SnM}^3_c\text{M}^4_d\text{O}_t$ , a nonaqueous electrolyte containing a lithium salt and a separator. At least one of the negative or positive electrode has a protective layer and  $\text{M}^3$  represents at least two elements selected from the group consisting of Al, B, P and Si;  $\text{M}^4$  represents at least one element selected from the group consisting of elements of groups 1 to 3 of the period table and halogen elements; c represents a number of from 0.2 to 2; d represents a number of from 0.01 to 1 provided that  $0.2 < c + d < 2$  and t represents a number of from 1 to 6.

Kawakami et al. relates to a secondary battery comprising lithium or zinc in the negative electrode. Kawakami et al. discloses that the reason why a large capacity lithium accumulator of the type that uses lithium metal as the negative pole has not been put into practical use is because the generation of dendrite of lithium, which is the main cause of a short circuit, cannot be prevented (col. 1, lines 35-40). Kawakami et al. also discloses that the same problem is encountered with batteries containing zinc in the negative poles.

Since an objective of Kawakami et al. is to specifically reduce dendrites of lithium and zinc in the negative electrode, one of ordinary skill in the art would not be motivated to use the negative electrode material of Idota et al. That is, there is no motivation that would lead one of ordinary skill in the art to replace the lithium or zinc negative material with the tin material of Idota et al. because an objective of Kawakami et al. is to prevent lithium or zinc dendrite

formation. The use of a negative electrode material other than lithium, lithium alloy, zinc or zinc alloy would defeat the purpose of Kawakami et al. Therefore, there is no motivation that would lead one of ordinary skill in the art to select a composite oxide containing tin from the various materials of Idota et al. and to use it in Kawakami et al.

Accordingly, the present invention is not rendered obvious in view of Kawakami et al. and Idota et al.

In view of the above, withdrawal of the foregoing rejection is respectfully requested.

**III. Obviousness-type Double Patenting Rejection**

In paragraph 5 at page 5 of the Office Action, claims 33, 35-37, 40-46, 52, 53 and 56 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-11 of U.S. Patent 6,365,299.

Applicants submit herewith a terminal disclaimer disclaiming the terminal part of any patent granted on the above-captioned U.S. Patent 6,365,299 which would extend beyond the expiration of the full statutory term of any U.S. Patent 6,365,299. Filing of the terminal disclaimer is not an admission of the propriety of the rejection.

Accordingly, Applicants respectfully request that the obviousness-type double patenting rejection be withdrawn.

**IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

**AMENDMENT UNDER 37 C.F.R. § 1.111**  
**U.S. Application No.: 10/046,708**

**Attorney Docket No.: Q67843**

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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**23373**

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